

Appl. No. 09/941,096
Amtd. Dated February 8, 2006
Reply to Office Action of December 8, 2005

••• R E M A R K S / A R G U M E N T S •••

The Official Action of December 8, 2005 has been thoroughly studied. Accordingly the following remarks are believed to be sufficient to place the application into condition for allowance.

Claims 1-19 are pending in this application.

Claims 1, 2, 4, 9, 10, 11, 13 and 15 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,882,769 to McCormack et al.

Claims 9-16, 18 and 19 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,939,1778 to Boich.

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McCormack et al. in view of U.S. Patent No. 5,244,716 to Thornton et al.

Claims 1-8 and 17 under 35 U.S.C. §103(a) as being unpatentable over Boich in view of Thornton et al.

For the reasons set forth below, it is submitted that all of the pending claims are distinguishable and allowable over the prior art or record and therefore, each of the outstanding prior art rejections should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

The Examiner has relied upon McCormack as disclosing:

...a laminate of two or more layers. One of the layers may be elastic. One of the layers may comprise a thermoplastic film and one may comprise a nonwoven fabric.

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The thermoplastic film may be breathable. See col. 4, line 53 - col. 5, line 65. The two layers are bonded together so that a plurality of bulges form continuously across the surface of the laminate. The bonds may be lines which extend in parallel across the laminate. See fig. 1 and also col. 7, lines 1-3.

The Examiner has relied upon Boich as disclosing:

...a sheet comprising an imperforate elastomeric film having a plurality of bulgy regions which are bonded to a fibrous nonwoven layer at the apex of the bulgy regions. See figures 4 and 5 which show the elastomeric sheet 10 and the nonwoven sheet 12 wherein the sheet 10 is bonded to the nonwoven 12 at points 16. The regions of the sheet 12 between the bonding point 16 are substantially flat. See figure 4. When the sheet is under tension as shown in figure 4, the bulgy areas project from the sheet and have a flat back portion. When the sheet is not under tension as shown in figure 5, the bulgy areas comprise opposing curved portions extending away from each other. The bulgy areas are solid. See figures.

The Examiner has relied upon Thornton as disclosing:

... discontinuously bonded material comprising an imperforate, water vapor permeable, liquid impermeable film layer such as a polyurethane layer and a fabric. The two layers are discontinuously bonded so that the fabric layer will be flat which the film layer is pleated into a plurality of parallel pleats. See figure 3a where 105 refers to the film and 100 refers to the fabric. The parallel pleats correspond to the claimed structure of uniformly spaced bulgy zones. The film may comprise a polyurethane material and may have a WVTR which would meet the claimed limitations. See col. 13, lines 19-38.

In combining the teachings of McCormack et al. and Thornton et al. the Examiner takes the position that:

...it would have been obvious to have employed a polyurethane film having the claimed WVTR as taught by Thornton. One of ordinary skill in the art would have been motivated to employ the polyurethane because Thornton teaches that such films are suitable for use in laminates comprising breathable film layers and fabric layers wherein the breathable film layer is puckered or pleated.

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In combining the teachings of Boich and Thornton et al. the Examiner has taken the position that:

One of ordinary skill in the art would have been motivated to employ the vapor permeable sheets of Thornton because Thornton teaches that such film are suitable for us in laminates comprising film layers and fabric layers in order to improve the comfort of users of articles comprising the laminate.

In the paragraph bridging pages 2 and 3 of the Official Action of December 22, 2004 the Examiner states:

Applicant argues that the portion of the structure of McCormack which corresponds to the substantially flat zones were not pointed out in the previous action. However, the areas which form the bonds correspond to the substantially flat zones. The bonding can be in the form of lines which extend in parallel across the laminate, see fig. 1 and col. 7, lines 1-3. Further, with regard to McCormack, either of the two layers 12, 14 in fig. 1 can be film or nonwoven. Therefore, the layer 12 can be a nonwoven and layer 14 can be the nonwoven layer. Therefore, the areas where the two or more layers are bonded correspond to the claimed substantially flat zones.

The Examiner's interpretation that the areas which form the bonds [in McCormack et al.] correspond to the substantially flat zones is inconsistent with the recited structure in applicant's independent claim 1.

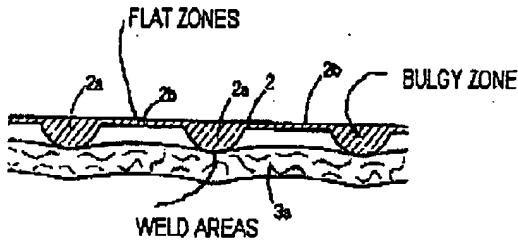
Accordingly, by the Examiner's own interpretation McCormack et al. fails to render applicant's claimed invention obvious.

Independent claim 1, requires, in part:

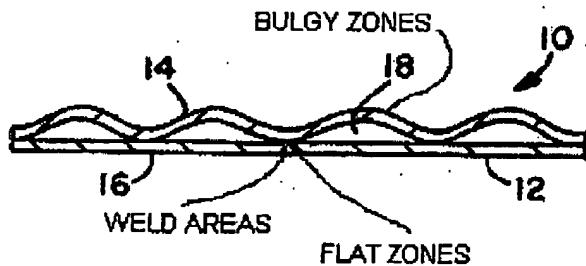
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- 1) "substantially flat zones extending continuously between adjacent ones of the bulgy structural zones;" and
- 2) "said thermoplastic synthetic resin film being welded along said bulgy structural zones to said thermoplastic synthetic resin fibrous sheet."

These limitations are consistent with applicant's Fig. 2:



If one attempted to apply the Examiner's interpretation of McCormack et al. using applicant's claim language the following would result:



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Since the Examiner has interpreted that the areas which form the bonds [in McCormack et al.] correspond to the substantially flat zones, they necessarily correspond to the weld zones (since these are the only points of contact between the two layers).

However, applicant's independent claim 1 requires, in part:

- 1) "substantially flat zones extending continuously between adjacent ones of the bulgy structural zones;" and
- 2) "said thermoplastic synthetic resin film being welded along said bulgy structural zones to said thermoplastic synthetic resin fibrous sheet."

If, according to applicant's claim limitations, the flat zones are between adjacent flat zones and the layers are welded at (or along) the bulgy zones, then the flat zones cannot correspond to the weld zone (the outcome of the Examiner's interpretation of McCormack et al.) or else they would correspond to the bulgy zones and therefore not be "between adjacent ones of the bulgy structural zones" as required by applicant's independent claim 1.

It therefore follows that the Examiner's interpretation of McCormack et al. is inconsistent with the recited structure in applicant's independent claim 1.

McCormack et al. according to the Examiner's interpretation, fails to meet the limitations of applicant's independent claim 1 and therefore does not anticipate applicant's claimed invention.

On page 5 of the Office Action the Examiner explains her position that:

"along" is defined as in a line parallel with the length or direction of'. The bonding in McCormack is "along" the bulgy zones. The claims only require bonding along, i.e., in a line parallel with the length or direction of, the bulgy zones and McCormack meets this limitation.

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The Examiner seems to be taking the term "along" completely out of context and otherwise abandoning any reasonable interpretation of McCormack.

The independent claims recite that the "thermoplastic synthetic resin film being welded along said bulgy structural zones to said thermoplastic synthetic resin fibrous sheet."

"Welded along said bulgy structural zones to said thermoplastic synthetic resin fibrous sheet requires that the thermoplastic synthetic resin film is welded to the thermoplastic synthetic resin fibrous sheet along the bulgy structural zones.

The Examiner's definition of "along" is in error. A more accurate definition of "along" is "through, on, or over the length of." (The Random House Dictionary 1978) or "over the length of" (www.dictionary.com).

MPEP §2111 states that "CLAIMS MUST BE GIVEN THEIR BROADEST
REASONABLE INTERPRETATION"

The same section of the MPEP cites *In re. Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28, noting that the court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would in interpreting claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification."

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One skilled in the art would not interpret "along" in the manner which the Examiner attempts.

Moreover, in order to apply McCormack et al. to applicant's claimed invention, the Examiner is required to structurally identify the structure where the thermoplastic synthetic resin film is welded to the thermoplastic synthetic resin fibrous sheet.

This leads only to the Examiner concluding that the weld lines in McCormack et al. are, in fact, not along, i.e. "on or over the length of" the Examiner's bulgy zones, but along the Examiner's interpreted flat zones in McCormack et al.

The Examiner has relied upon Boich as teaching an "imperforate elastomeric film having a plurality of bulgy regions which are bonded to a fibrous nonwoven layer at the apex of the bulgy regions."

The Examiner states that:

When the sheet is under tension as shown in figure 4, the bulgy areas project from the sheet and have a flat back portion. When the sheet is not under tension as shown in figure 5, the bulgy areas comprise opposing curved portions extending away from each other.

The flaw in the Examiner's reliance and interpretation of Boich is that the Examiner's interpreted bulgy areas correspond to the discrete connection sites 16, which as shown in Figs. 3 and 4 fail to meet the limitations of applicant's independent claims that the bulgy structures "extend[ing] continuously in one direction in parallel and substantially uniformly spaced apart from one another."

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Accordingly, Boich cannot be relied upon as anticipating applicant's claimed invention.

The Examiner has relied upon Thornton et al as teaching a polyurethane film having a specific WVTR.

This further reliance upon Thornton et al. does not address or overcome the structural differences and distinctions between applicant's claimed invention and each of McCormack et al. and Boich as discussed above.

Accordingly, neither the combination of McCormack et al. and Thornton et al. nor the combination of Boich and Thornton et al. render applicant's claimed invention obvious under 35 U.S.C. §103.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicant's claimed invention.

Moreover, it is submitted that the Examiner cannot properly rely upon the prior art under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejections of the claims should hence be withdrawn.

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Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicant's patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



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